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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,848	01/19/2001	David R. Rhee	RHEE 4	9239

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EXAMINER

BRANCOLINI, JOHN R

ART UNIT PAPER NUMBER

2153

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,848

Applicant(s)

RHEE, DAVID R.

Examiner

John R Brancolini

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-27 are pending in the application.

Priority

A claim for priority has been made to US Provisional 60/177163. The effective filing date of the application is January 20, 2000.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- 140 and 160 mentioned on page 6 line 6.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- Figure 1 items 40, 100.
- Figure 4 items 420, 430.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the

Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 14-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorfman et al. (US Patent 6563912), hereinafter referred to as Dorfman.

In regards to claim 1, Dorfman discloses a messaging system providing access for authorized users to pre-stored messages, wherein at least one of said pre-stored messages includes multiple message portions constituting an initial message and one or more attachments to said initial message, a method for providing access to selected portions of said pre-stored messages comprising the steps of:

- Providing a signal to a user indicative of at least one of said pre-stored messages being available for access by said user (the email is forwarded to an email account where a visual representation signals the user of the presence of a new

message, an additional signal is given as the attachment appears, col 5 lines 44-54, col 5 line 62 – col 6 lines 10).

- Upon selection by said user of an available pre-stored message which includes multiple message portions, providing said user a different signal indicating that said selected pre-stored message includes both an initial message and one or more attachments (upon opening an initially received mail message, on or more attachments will appear as an audio attachment indicating multiple message attachments, col 5 lines 62-67).
- Providing a user option for selecting one message portion from a selected pre-stored message which includes an initial message with one or more attachments (the user can open the attachment in a playback utility, col 6 lines 1-2).
- Upon selection by a user of said one message portion of said selected pre-stored message, causing only said selected portion to be provided to said user (upon receiving an email message, a user is signaled to the appearance of an attachment, which the user selects, which results in the attached voice message being provided to the user, col 5 line 65 – col 6 line 10).

In regards to claim 2, Dorfman discloses the user option for selection of said one message portion includes an initial selection choice between said initial message and said attachments (the user reads the initial email, seeing the additional attachment, and

chooses to open the audio attachment, and if the users also chooses, the user can listen to all available messages, col 5 line 65 – col 6 line 10).

In regards to claim 3, Dorfman discloses an exercise of said initial selection choice in favor of said attachments provides a further option to select a given one of said attachments associated with said selected pre-stored message (a user opens an initial email message seeing any voice mail messages appearing as an attachment to the mail, then selecting one of the available messages for listening, col 5 line 62 – col 6 lines 10).

In regards to claim 4, Dorfman discloses the selection of said given one of said attachments is iteratively repeated to select additional ones of said attachments associated with said selected pre-stored message (a user can utilize the system to listen to all available messages, iteratively stepping through each email attachment individually, col 5 line 65 – col 6 line 10).

In regards to claim 5, Dorfman discloses at least one of said user selection steps is initiated by said user in response to a prompt generated by said messaging system (the initial prompt provided by the system is the forwarding of the voice message as an email to the client, which the clients email viewer recognizes as a new message with an individual attachment, col 5 lines 43-53, 61-65).

In regards to claim 6, Dorfman discloses the user response includes an interrupt signal to said system prompt (the initial prompt provided by the system is the forwarding of the voice message as an email to the client, which the clients email viewer recognizes as a new message, allowing the user to send an interrupt signal to the system for access to the voice mail attachment, the interrupt causing the attachment to be loaded into the player, col 5 lines 43-53, 61-67, col 6 lines 1-10).

In regards to claim 7, Dorfman discloses the user response is manifested by engaging a pre-designated key on a keypad associated with said messaging system (one input device possible is a personal email client, complete with a keyboard, col 5 lines 11-14).

In regards to claim 8, Dorfman discloses selectable portions of said pre-stored messages are stored in a memory associated with a computer processor, and said user response is manifested by selection of said desired message portion via a graphical user interface associated with said computer processor (an email client is shown, complete with a processor, memory, and a graphical display for running an email reader, allowing the user access to the desired message, col 5 lines 11-17).

In regards to claim 9, Dorfman discloses the messaging system is a voice mail system (a voice mail system and server, seen in Figure 2 Item 10, is present along with the email system, col 4 lines 45-50).

In regards to claim 10, Dorfman discloses the provision of said selected portion to said user is implemented via an audio playback of said selected portion (an audio player application is provided which allows the user to play the message, figure 7, col 5 line 65 – col 6 line2, col 7 lines 41-46).

In regards to claim 11, Dorfman discloses a user option to return to a start position upon initiation by said user of a pre-designated interrupt signal (the digital audio playback device includes an option to replay, col 7 lines 41-46).

In regards to claim 14, Dorfman discloses the pre-stored messages may be coded to restrict selection of one or more portions of a message so coded to a predetermined number of user-selection operations (the message is encoded to work with the playback utility, which gives the user the predetermined options of playing, replying, forward and deleting, col 7 lines 41-46).

In regards to claim 15, Dorfman discloses the pre-stored messages may be coded to restrict a forwarding of one or more portions of a message so coded to one or more identified users (the system may be instructed by a user to code messages for forwarding to a specific email account, col 5 lines 43-53).

In regards to claim 16, Dorfman discloses a messaging system for providing authorized users of said system with access to selected portions of pre-stored messages, wherein at least one of said pre-stored messages includes a plurality of message portions constituting an initial message and one or more attachments to said initial message, said system comprising:

- Message available indicator operative to provide a signal to a user of at least one of said pre-stored messages being available for access by said user (the email is forwarded to an email account where a visual representation signals the user of the presence of a new message, an additional signal is given as the attachment appears, col 5 lines 44-54, col 5 line 62 – col 6 lines 10).
- Input device responsive to user input to select an available message for further processing by said system (an email client is shown, allowing the user access to the desired message, col 5 lines 11-17).
- Message attachments indicator operative provide a signal to said user indicating that a selected available message includes at least one attachment (a user opens a message seeing any voice mail messages appearing as an attachment to the mail, col 5 lines 62-67).
- Selection interface operating in conjunction with said input device for providing said user an option to select a desired portion of a message that includes attachments, and for accepting a signal from said user identifying said selected desired portion (at the email client, utilizing an email viewer, the user can select

the attachment for opening in a playback utility provided by the system, col 5 line 62 - col 6 line 2).

- Output device for providing said selected desired portion to said user (the attachment is opened in a playback utility, col 6 lines 1-10, the system also includes speakers for audio playback, figure 2).

In regards to claim 17, Dorfman discloses the selection interface is operative to provide said user an initial selection choice between said initial message and said attachments (the user reads the initial email, seeing the additional attachment appearing as an additional indicator representing the voice mail attachment, and chooses to open the audio attachment, and if the users also chooses, the user can listen to all additional voice mail messages associated with the initial email message, col 5 line 65 – col 6 line 10).

In regards to claim 18, Dorfman discloses the selection interface provides a further option to select a given one of said attachments associated with said selected pre-stored message (a user opens an initial email message seeing any voice mail messages appearing as an attachment to the mail, then selecting one of the available messages for listening, col 5 line 62 – col 6 lines 10).

In regards to claim 19, Dorfman discloses upon selection by said user of said given one of said attachments, said selection interface further provides an option to

repeatedly select additional ones of said attachments (a user can utilize the system to listen to all available messages, iteratively stepping through each email attachment individually, col 5 line 65 – col 6 line 10).

In regards to claim 20, Dorfman discloses the input device includes a keypad (one input device possible is a personal email client, complete with a keyboard, col 5 lines 11-14).

In regards to claim 21, Dorfman discloses including a computer processor, an associated memory and an associated graphical user interface, wherein selectable portions of said pre-stored messages are stored in said memory and said user selection of a desired message portion is manifested via said graphical user interface (an email client is shown, complete with a processor, memory, and a graphical display for running an email reader, allowing the user access to the desired message, col 5 lines 11-17).

In regards to claim 22, Dorfman discloses the system is configured for storing and processing voice mail (a voice mail system and server, seen in Figure 2 Item 10, is present along with the email system, col 4 lines 45-50).

In regards to claim 23, Dorfman discloses the output device is configured as an audio playback device (an audio player application is provided which allows the user to play the message, figure 7, col 5 line 65 – col 6 line 2, col 7 lines 41-46).

In regards to claim 24, Dorfman discloses including a coding means operative to code said pre-stored messages to restrict selection of one or more portions of a message to a predetermined number of user-selection operations (the message is encoded to work with the playback utility, which gives the user the predetermined options of playing, replying, forward and deleting, col 7 lines 41-46).

In regards to claim 25, Dorfman discloses including a coding means operative to code said pre-stored messages to restrict a forwarding of one or more portions of a message to one or more identified users (the system may be instructed by a user to code messages for forwarding to a specific email account, col 5 lines 43-53).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-13, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorfman in view of Hoss et al. (US Patent 5951638), hereinafter referred to as Hoss.

In regards to claim 12, Dorfman discloses all the limitations of claim 1, but fails to directly disclose formatting an email into a header and body, the header including address, location and status information and the body including message content.

Hoss discloses a system for integrating multimedia message by attaching voice mail messages to an email address to notify a user of an available message. Hoss teaches the creation of an email with two separate sections, a header and a body. The header includes all necessary identification information, such as originator information like address and locations, the date and time received and the subject of the email, which can be interpreted as status information (Hoss, col 5 lines 19-22). Also, Hoss shows a text portion of the message contained in the body of the email (Hoss, col 5 line 16-17). Hoss shows that by maintaining the header and body before adding the attachment file, one has an effective method of storing, receiving, and managing messages which are in different media formats (Hoss, col 2 lines 46-51).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Dorfman to include maintaining a header and a body to the email message as taught by Hoss to provide an effective method of storing, receiving, and managing messages which are in different media formats.

In regards to claim 13, Hoss discloses the header relies on a scheduler for delivery of the messages, the scheduler including a series of pointers in a pointer table, including one to the starting position of the initial message, which is a pointer to the associated initial message (col 9 lines 22-27, 33-36, the pointer to the voice-mail call

entry point is seen as a pointer to a voice mail message, or the associated initial message of the system).

In regards to claim 26, Dorfman discloses all the limitations of claim 16, but fails to directly disclose formatting an email into a header and body, the header including address, location and status information and the body including message content.

Hoss discloses a system for integrating multimedia message by attaching voice mail messages to an email address to notify a user of an available message. Hoss teaches the creation of an email with two separate sections, a header and a body. The header includes all necessary identification information, such as originator information like address and locations, the date and time received and the subject of the email, which can be interpreted as status information (Hoss, col 5 lines 19-22). Also, Hoss shows a text portion of the message contained in the body of the email (Hoss, col 5 line 16-17). Hoss shows that by maintaining the header and body before adding the attachment file, one has an effective method of storing, receiving, and managing messages which are in different media formats (Hoss, col 2 lines 46-51).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Dorfman to include maintaining a header and a body to the email message as taught by Hoss to provide an effective method of storing, receiving, and managing messages which are in different media formats.

In regards to claim 27, Hoss discloses the header relies on a scheduler for delivery of the messages, the scheduler including a series of pointers in a pointer table, including one to the starting position of the initial message, which is a pointer to the associated initial message (col 9 lines 22-27, 33-36, the pointer to the voice-mail call entry point is seen as a pointer to a voice mail message, or the associated initial message of the system).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Hicks, III (US Patent 6304573), a method and apparatus for recording and storing voice messages and forwarding the messages to a user over a network.
- Irribarren (US Patent 5841966), a distributed messaging system allowing a user to record a voice message for another user, the system attaching the file as to an email which the recipient will receive as an email message.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R Brancolini whose telephone number is (703) 305-7107. The examiner can normally be reached on M-Th 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone


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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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